UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Kaveh Kianush, Oswald Josef Moonen, and Jan Geert Prummel

Appeal No. 2005-2151
Application No. 09/822,473

ON BRIEF

Before KRASS, DIXON, and NAPPI, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a narrow band AM front end receiver. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. Receiver comprising an RF stage for receiving an antenna signal from an inductive antenna, a processing stage for processing the output signals of the RF stage and an output for supplying an audio signal, characterized in that the RF stage comprises electronically switched capacitors, controlled by a switch control circuit, for adjusting front-end selectivity of the RF stage to correspond to an established tuning frequency.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

MacDonald	2,148,633	Feb. 28, 1939
Yasooka Tadashi (Yasooka)	JP 06-125280	Jun. 5, 1994

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Feb. 24, 2005) for the examiner's reasoning in support of the rejections, and to the brief (filed Dec. 6, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. From our review of appellants' brief, we find that appellants have included headings for claims 1 and 3 as a grouping and claim 2 as a separate grouping.

35 U.S.C. § 102

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d

1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference **(see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

From our review of the examiner's rejection, responsive arguments and the teachings of Yasooka, we find that the examiner has at least established a ***prima facie*** case of anticipation of independent claim 1. We find that in the examiner's responsive arguments, the examiner has further elaborated upon the grounds of (new) rejection made in the final rejection, and we find that appellants have not filed a reply brief to further address the examiner's further clarification of the grounds of rejection. Therefore, we will accept the examiner's statement of the grounds of rejection as correct since it has not been rebutted by appellants. The totality of appellants' argument in the brief is as follows:

> there is no switching of capacitors under electronic control in Yasooka. Rather, the switch 12c is, from all indications, manually switched. Furthermore, the "frequency changing circuit" 3 of Yasooka is simply a well known downconverter, i.e., RF mixer. It does not in any way affect the capacitors12a and 12b. Note the description on the bottom third of page 2 of the translation of Yasooka, which describes the received frequency f1 being downconverted to an intermediate frequency f3 using a local oscillator signal of frequency f2, where f3=f2=f1.

While the examiner repeats the statement of the rejection from the final rejection which states "switch control circuit 3 for adjusting front tend selectivity of the RF stage," the

examiner clarifies in the responsive arguments that time 6 of Yasooka is the switch control circuit used for controlling the switching 12c of electronically switching capacitors 12a and 12b and further directs attention to paragraph [0020]. We agree with the examiner that Yasooka teaches an electronic formula frequency complement means 6 to select the appropriate frequency by adjusting the capacitance. (See also Yasooka paragraph [0013].) We find no indication in the file that appellants filed a Reply Brief to address the above teachings of Yasooka or the examiner's reliance thereon. Therefore, we find that appellants have not shown error in or rebutted the examiner's ***prima facie*** case of anticipation. Therefore, we will sustain the examiner's rejection of independent claim 1 and dependent claim 3.

35 U.S.C. § 103

Appellants argue that the teachings of MacDonald do not remedy the deficiencies of Yasooka as argued with respect to the rejection under 35 U.S.C. § 102. We do not find this argument to be specific with respect to the limitations of dependent claim 2. Therefore, we do not find the argument persuasive, and we will sustain the rejection of dependent claim 2.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3 under 35 U.S.C. § 103 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRM

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

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